



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

~~Martin MIEHLING~~

Group Art Unit: 2841

~~Application No.: 09/512,223~~

Examiner: T. Dinh

~~Filed: February 24, 2000~~

Docket No.: 104142

~~For: TRANSPOUNDER AND INJECTION-MOLDED PART AND
METHOD FOR MANUFACTURING SAME~~

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RESPONSE TO RESTRICTION REQUIREMENT

7/24/01
Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

In response to the Restriction Requirement mailed July 2, 2001, Applicant provisionally elects to prosecute the claims of Group I (claims 1-15) drawn to an electrical circuit and a transponder. Applicant respectfully traverses the Restriction Requirement.

According to the Restriction Requirement, the invention of Group I and the invention of Group II (claims 16-28 drawn to a process of making the transponder) are related as product (Group I) and process of making the product (Group II). It was asserted that the inventions are distinct because the product could be made by a materially different process such as any process using chemicals or adhesives.

Applicant respectfully disagrees with the assertion that the product could be made by a process utilizing chemicals or adhesives instead of a thermoplastic resin in molten form. As explained in the specification and recited in the product claims, at least an integrated circuit and an antenna must be encapsulated within a capsule of a thermoplastic resin. It is not seen

how this product or the capsule could be made with chemicals or adhesives. Without the thermoplastic resin, the product as claimed cannot be obtained. Thus, the product could not be made by the process alleged in the Restriction Requirement. Reconsideration and withdrawal of the Restriction Requirement are thus respectfully requested.

Moreover, according to MPEP §803, there are two requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required . . . ". Applicant respectfully submits that the Restriction Requirement has also failed to establish the second requirement set forth in MPEP §803, i.e., that a serious burden exists on the Examiner if restriction is not required between the Groups of claims.

In the present application, the process recited in the claims of Group II fully includes the requirements of the product of claim 6 of Group I. Thus, there is a clear connection between the claims of the two groups, and a search for the claims of Group I, to be complete, should also necessarily include a search for the claims of Group II.

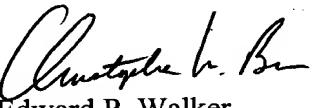
In view of this, it is respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." For at least the foregoing reasons, and in order to avoid unnecessary delay and expense to applicant and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

Finally, it must be noted that as the process of claim 16 fully includes the limitations of the transponder of elected claim 6, upon allowance of the product claims, the process

claims of Group II must be rejoined and similarly allowed. The Patent Office is directed to MPEP §821.04.

Early and favorable action on the merits with respect to all of pending claims 1-28 is respectfully requested.

Respectfully submitted,


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EPW:CWB/wp

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